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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,134	12/15/2000	Dante Pellegrini	22571-166778 RSB	8140
26694	7590	07/03/2006	EXAMINER	
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998			BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/736,134	PELLEGRINI, DANTE	
	Examiner	Art Unit	
	Jason M. Borlinghaus	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/19/05, 5/20/05 and 10/04/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language

contained within said cited prior art reference while unquoted language contained within parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as “reading on” or being “mapped to” the claim language prior to such parenthetical inclusions.

Claims 1 – 5, 7 – 11, 14 – 18, 20 – 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (US Patent 5,537,314).

Regarding Claims 1 - 3, Kanter discloses a method for transferring ownership of an asset, comprising the steps of:

- issuing redeemable tokens (“points”) having defined redemption values (“dollar amounts”) to one or more participants over a network (“communication lines”), wherein the participants interface with the network using wired or wireless devices (“computer processing unit”), and wherein each issued redeemable token (“point”) is associated with a participant. (see col. 4, lines 39 – 67; col. 16, lines 4 – 35; fig. 2);
- probabilistically (via “raffle”) selecting at least one redeemable token (“entry”). (see col. 16, lines 38 – 56 and col. 20, lines 19, 41);
- performing a function related to transferring an ownership right to the asset to a participant who is associated with a selected redeemable token (“credit and/or award” redemption). (see col. 16, lines 38 – 61); and
- specifying a redemption value for the asset (“items of merchandise...depended on the amount of points achieved by the participant.” – establishing the specification of a redemption value

(“amount of points”) for the asset (“merchandise”) – see col. 5, lines 22 – 28).

Kanter does not teach underlined claim limitations – a method comprising the steps of:

- probabilistically selecting at least one redeemable token, upon or after redemption value of the issued redeemable tokens reaches a predefined cumulative value;
- specifying a redemption value for the asset that corresponds to the predefined cumulative value; and
- wherein the asset is equal to the predefined cumulative value.

While Kanter does not explicitly teach the selecting of a redeemable token “upon or after redemption value of the issued redeemable tokens reaches a predefined cumulative value,” Kanter does disclose “at either the culmination of the program or a set period within the program, the points are converted to a direct cash payment.” (see col. 4, lines 59 – 61). The “set period” for culmination of the program, either as a raffle or a cash outlay, could be established according to any predetermined unit of measurement that the inventor desired, such as measurements of time, volume of tokens issued or cumulative value of said tokens. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

To the best knowledge of the examiner the only method through which a probabilistic (“raffle”) transfer of asset (“award”) ownership can function without operating at a financial loss would be when the cumulative value of tokens (value of

“raffle entries”), at least, equals the redemption value of the asset (“award”). For example, a raffle for a bicycle with a redemption value of \$100 would need to generate, at least, \$100 in raffle ticket sales to prevent the system from operating at a financial loss.

This financial imperative to prevent the system from operating at a loss is reiterated by Kanter, “When the independent contractor gives the catalog out for free, the independent contractor **does not recoup the investment he/she made to acquire the catalog. This results in an independent contractor's cash flow becoming depleted.**” (emphasis added – see col. 4, lines 18 – 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kanter to specify a redemption value for the asset and a predefined cumulative value of tokens, and selecting a winner when the predefined cumulative value of tokens, at least, reached the redemption value of the asset, preventing the system to operate at a financial loss.

Regarding Claims 4 – 5, Kanter discloses a method wherein:

- the redeemable tokens (“points”) are issued in response to a participant meeting an incentive criterion (“incentive program”). (see col. 5, lines 10 – 27).

Kanter does not teach the underlined claim limitation – a method wherein:

- the redeemable tokens are issued in response to a participant purchasing the redeemable tokens for a specified price.

The purchasing of tokens, points and/or entries at a specified price for entrance into a probabilistic award program, such as purchasing raffle tickets for a specified price for entrance into a raffle drawing, is old and well known in the art of games of chance. It would have been obvious to one of ordinary skill in the art to have modified Kanter to have incorporated the ability to purchase tokens, as is old and well known in the art, allowing for participants an additional traditional method through which to gain entrance to the program.

Regarding Claims 7 – 9, Claims 7 – 9 recite similar limitations and/or would have been obvious based upon claims rejected above, Claims 1 – 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 10 - 11, Claims 10 - 11 recite similar limitations and/or would have been obvious based upon claims rejected above, Claims 1 – 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 14 – 18, 20 – 21 and 23, further system claims would have been obvious from method claims rejected above, Claims 1 – 5, 7 – 9 and 11, and are therefore rejected using the same art and rationale.

Claims 6, 12 – 13, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter, as applied to Claims 5, 11, 18 and 21 above, and further in view of Walker (Walker, Leslie. *Where You Can Get Rich Click*. *The Washington Post*. Washington, DC. November 18, 1999. p. E01).

Regarding Claim 6, Kanter does not teach underlined limitation - a method wherein:

- the incentive criterion requires browsing one or more web pages.

Walker discloses a method wherein:

- the incentive criterion requires browsing one or more web pages.
(lwon.com awards “points” as part of an incentive program for viewing
and/or clicking through web page content – see p. E01).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kanter by incorporating the token issuance incentive criterion being the browsing of web pages, as disclosed by Walker, as token issuance premised upon the browsing of web pages was already utilized at the time of the invention as an advertising technique designed to lure additional viewers of Internet content.

Regarding Claim 12, Claim 12 recites similar limitations and/or would have been obvious based upon claim rejected above, Claim 6, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claim 13, Claim 13 recites similar limitations and/or would have been obvious based upon claims rejected above, Claim 1 - 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 19 and 22, further system claims would have been obvious from method claims rejected above, Claim 6, and are therefore rejected using the same art and rationale.

Response to Arguments

Applicant's arguments filed 5/20/05 have been fully considered, and are persuasive, in part, and not persuasive, in part.

In response to applicant's arguments concerning rejections based upon §112, first paragraph and §101, examiner hereby withdraws such rejections.

In response to applicant's arguments concerning the rejection under §103, examiner asserts that the examiner can establish a prima facie case of obviousness based upon the previously cited prior art reference of Kanter. In the current office action, the current examiner has attempted to elaborate upon the work of his predecessor, hopefully, providing the applicant with a better mapping of the prior art reference to the claimed invention.

Furthermore, examiner wishes to remind applicant that the recitation of the intended use or purpose of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or fulfilling said purpose, then it meets the claim. *Ex parte Masham, 2 USPQ2d 1647 (1987).*


Therefore, examiner asserts that applicant's classification of Kanter as an "award program," which the applicant distinguishes from an "asset ownership transfer vehicle," is incorrect. As the "award program" of Kanter transfers ownership of an asset ("the award") from the one party to another, Kanter is an "asset ownership transfer vehicle."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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